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10/814,679

03/31/2004

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EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

05/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,679

Applicant(s)

HOOD ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-47 is/are pending in the application.
- 4a) Of the above claim(s) 16-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15 and 34-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1, 3, 5, 7, 8, 10-12, 34-40, 42-44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sallee, U.S. Patent No. 5,976,643 for the reasons set forth in paragraph 7 of the previous action. With regard to the limitation that the planar portion and the projecting portion are integrally molded, Sallee teaches that the attachment of the projecting portion to the base portion may be "permanent". See col. 5, lines 30-45. A structure which is permanently bonded is an integral structure. With regard to the limitation that the structure is molded, a molded structure is one which is produced by a molding process. Sallee does not teach a molding process but teaches the claimed integral structure. The instant claims are drawn to a product and not to how the product is made. "The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

The use of 35 USC 102/103 rejections for product by process claim has been approved by the courts. "[T]he lack of physical description in a product - by - process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product - by - process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown , 173 USPQ 685, 688 (CCPA 1972).

Therefore, in the instant case, the burden is on the Applicant to show that the claimed process produces an unobvious difference between the claimed product and the prior art product.

2. Claims 1,9,10, and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zuiddam et al, U.S. patent No. 4,866,808 for the reasons set forth in paragraph 8 of the previous action . With regard to the limitation that the base portion and projecting portion are integral, Zuiddam teaches that the bristle portions can be "fixedly positioned" into the U-shaped channels, (col. 3, lines 58-61) and that the "U-shaped profiles can be ultrasonically welded to the base material, (col. 3, lines 38-50). The U-shaped channel together with the bristles

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correspond to the claimed projecting portion and the base corresponds to the claimed planar portion. Therefore, Zuiddam teaches an integral structure. With regard to the limitation that the structure is a molded structure, as set forth above, since the instant claims are article claims, the burden is on the Applicant to show that the method by which the product is made, (molding), produces an unobvious difference between the claimed structure and the prior art structure.

3. Claims 1,2,5,7,10,12 and 15, 47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matsui et al, U.S. Patent No. 4,525,404 as set forth in paragraph 9 of the previous action. With regard to the limitation that the structure is integral, the projecting piles project from the planar base portion and form an integral or one piece structure. With regard to the limitation that the structure is molded, as set forth above, since the instant claims are article claims, the burden is on the Applicant to show that the method by which the product is made, (molding), produces an unobvious difference between the claimed structure and the prior art structure.

4. Claims 1,5,7,10 and 14, 47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukuda et al as set forth in paragraph 10 of the previous office action. With regard to the limitation the structure is integral, the naps and the base fabric are one piece and are therefore integral. With regard to the limitation that the structure is molded, as set forth above, since the instant claims are article claims, the burden is on the Applicant to show that the method by

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which the product is made, (molding), produces an unobvious difference between the claimed structure and the prior art structure.

5. Claims 34, 39, 41, 44 and 46 are rejected under 35 U.S.C. 102(e) as anticipated by Valyi et al, U.S. Patent No. 6,132,669 as set forth in paragraph 11 of the previous action. With regard to the limitation that the structure is integral, the film and the molten plastic are formed into one piece. The forming takes place in a mold and thus the resulting structure is molded.

6. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallee as set forth in paragraph 13 of the previous action.

7. Claims 9 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallee in view of Nesbitt, U.S. Patent No. 5,549,938 as set forth in paragraph 14 of the previous action.

8. Claims 13 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallee in view of Rawlinson, U.S. Patent No. 4,329,196 as set forth in paragraph 15 of the previous action.

9. Claims 14 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallee in view of Sesselmann for the reasons set forth in paragraph 16 of the previous action.

10. Claims 35-37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valyi et al as set forth in paragraph 17 of the previous action.

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11. Claims 38, 40 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valyi et al in view of Allan et al, U.S. Patent No. 5,851,474 as set forth in paragraph 18 of the previous action.

12. Applicant's arguments filed 3/8/07 have been fully considered but they are not persuasive.

13. Applicant argues that molded is a structural term and that claims 1 and 34 are not product by process claims. However, a claim which includes a limitation such as molded, (or the other examples Applicant has provided such as laminate, woven, bonded, etc.) , is considered in its entirety, like any claim, in order to determine the scope of the claim. In this case, the recitation is that the structure is molded. This is, as Applicant points out, both a process limitation, in that it states how the structure is made, (by molding), and also a structural limitation, in that it is reciting that the structure is molded, (and also, integral in this case). However, the issue is whether the product which is described as being formed by molding is different than a product which is described as being formed by another method, such as ultrasonic bonding, lamination etc. Applicant's citation of the word "laminate" is applicable to this situation. A structure comprising two layers which is described as a laminate could be formed by a lamination process, (i.e., heat and pressure). The same structure could also be formed, however, by another process such as coextrusion, flame lamination, solvent bonding, etc. In that case, even where the product was described as a laminate, but the prior art product was formed by, for example, coextrusion, since the resulting structure would apparently

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be the same, the art would anticipate the claim. The instant application is similar. Here, the claims recite integrally molded. The prior art products are not formed by integrally molding. However, the prior art products are permanently bonded entities, which appear to have the same structure as an article which is integrally molded. Thus, while the process by which the article is formed is different, the resulting product appears to be the same. Additionally, there is nothing on the record to distinguish the difference between an article wherein two elements are permanently united, such as by ultrasonic welding or other permanent known means, and a molded product. Assuming the materials are the same, which is the case between the instant claims and the prior art references, it does not appear that there would be a structural difference between a molded article and an otherwise identical article wherein the two elements were united by another means. Since the instant claims are process claims, the burden is on the applicant to show that the process difference results in an unobvious difference between the prior art products and the claimed products. The situation with a claim which recited "woven" is somewhat different, since a structure which is formed by weaving will be definition have a structure which is different than a structure which is formed by knitting, or uniting fibers by needlepunching or other mechanical means. Therefore, while Applicant argues that "integrally molded thermoplastic" is an adjective which defines the claimed "structure", the issue is what structure is imparted by these terms which would not be there if they were formed by another process. Molding is a means for forming, shaping or uniting elements. It is different than weaving in that other processes can be used to form, shape or unit elements and produce a structurally

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seemingly identical material, which is not the case with weaving. Further, there is nothing on the record showing that there is a structural difference between the molded articles and the claimed articles in terms of the finished structure and therefore, the rejections are maintained as set forth above.

14. With regard to Sallee, Applicant argues that there is nothing in Sallee which teaches a molded structure. However, Sallee teaches that the attachment of the projecting portion to the base portion may be "permanent". See col. 5, lines 30-45. A structure which is permanently bonded would be an integral structure and there is nothing on the record which would structurally distinguish such a permanently bonded integral structure from a molded integral structure. Therefore, the rejection is maintained.

15. With regard to Zuiddam, Applicant argues that there is no integral connection disclosed between the filaments and the profiles. With regard to the limitation that the base portion and projecting portion are integral, Zuiddam teaches that the bristle portions can be "fixedly positioned" into the U-shaped channels, (col. 4, lines 58-61) and that the "U-shaped profiles can be ultrasonically welded to the base material, (col. 3, lines 38-50). The U-shaped channel together with the bristles correspond to the claimed projecting portion and the base corresponds to the claimed planar portion. Although Applicant argues that only the u shaped channel members and the straps are ultrasonically welded, Zuiddam also teaches fixedly positioning the bristles in the U shaped channels. The result is an integral structure which appears to be identical to the claimed structure. The structure is permanently bonded into an integral structure and

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there is nothing on the record which would structurally distinguish such a permanently bonded integral structure from a molded integral structure. Therefore, the rejection is maintained.

16. Applicant argues with regard to Matsui that no obviousness rejection is set forth. However, the claim states that the prior art Matsui reference teaches the claimed structure but that Matsui does not teach molding but that the burden is on Applicant to show that the process difference, "molding", produces an unobvious difference between the prior art product and the claimed product. However, the structure of Matsui is a one piece or unitary structure. One piece, unitary and integral all mean the same thing and therefore the rejection is maintained. Applicant argues that Matsui teaches that the pile is produced by weaving, knitting or the like. However, Matsui teaches an integral structure where the piles extend from the base and the two form an integral unit. Therefore, the burden is on Applicant to show an unobvious difference between the claimed invention and the prior art product.

17. With regard to Fukuda, Applicant argues that a fabric cannot be an integral structure. However, the fabric of Fukuda is formed so that the projecting portions are integral with the base, in that they project from the base and are permanently associated with the base. Therefore the fabric is integral.

18. With regard to Valyi, Applicant argues that Valyi is a laminated structure and does not teach the two different polymers making up the two different projecting elements. However, as set forth in paragraph 8 of the office action mailed 12/21/05,

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Valyi teaches that two different polymers can be applied to the base to form the projecting elements. Therefore, the rejection is maintained.

19. Applicant argues that ultrasonic welding and molding are not necessarily interchangeable processes. However, the issue is not so much whether they are interchangeable processes so much as whether a product which is integrally joined by ultrasonic welding or another permanent bonding method is the same structurally as an article wherein segments are joined or formed by molding. It is the examiner's position that the record at this point does not provide any reason to distinguish the final products which are made by these different processes.

20. Applicant argues that ultrasonic welding could be a more expensive process than a molding process. However, the rejection does not proposed substituting the particular process of Zuiddam for the claimed process, but instead states that the final products in each appear to be the same.

21. With regard to integral, the word integral is given its broadest reasonable interpretation which means entire, complete, whole. A material which had two parts which were permanently united would be an integral, or entire, complete or whole structure.

22. Applicant argues that the word integral or integrally is combined with molded and thus defines a particular structure. It is agreed that integral defines a structure, but the prior art products which are formed into entire, whole or complete structures meet the "integral" limitation.

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23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

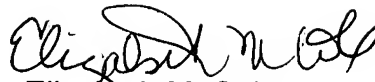
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

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A handwritten signature in black ink, appearing to read "Elizabeth M. Cole", written in a cursive style.

Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c